REMARKS

Claims 1-21 were pending in this application.

Claims 19-21 have been allowed.

Claims 1-18 have been rejected.

Claims 22 and 23 have been added.

Claims 1-23 are now pending in this application.

Reconsideration and full allowance of Claims 1-23 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1 and 10 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,788,882 to Geer et al. ("*Geer*"). This rejection is respectfully traversed.

A prior art reference anticipates a claimed invention under 35 U.S.C. § 102 only if every element of the claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP § 2131; In re Bond, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)*). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP § 2131; In re Donohue, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)*).

Geer recites a digital video recorder (DVR) capable of storing programs from multiple channels onto a mass storage device. (*Abstract*). In particular, the DVR includes a dynamic random access memory (DRAM) 120a, which stores data representing programs from multiple channels in circular buffers 310a-310n. (*Col. 12, Lines 35-41*). The data in the circular buffers

310a-310n is then written into different files on the mass storage device 120b. (*Col. 12, Lines 42-67*).

Claims 1 and 10 clearly recite that a "controller" is capable of creating a "data file" on a "storage disk" and causing "video data" to be stored sequentially in the data file. While *Geer* discloses the use of circular buffers 310a-310n to record programs from multiple channels, the circular buffers 310a-310n are in the dynamic random access memory 120a, not the mass storage device 120b. *Geer* never mentions creating a data file on a "storage disk" and causing video data to be stored in the data file on the "storage disk" as recited in Claims 1 and 10.

For these reasons, *Geer* fails to anticipate all elements of Claims 1 and 10. Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1 and 10.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 2-9 and 11-18 under 35 U.S.C. § 103(a) as being unpatentable over *Geer* in view of U.S. Patent No. 6,434,748 to Shen et al. ("*Shen*"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP § 2142; In re Fritch, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)*). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re*

Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)*). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)*).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)*). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP § 2142*).

As shown above in Section I, Claims 1 and 10 are patentable over *Geer*. The Office Action relies on *Shen* as allegedly disclosing various elements recited in Claims 2-9 and 11-18. The Office Action does not rely on *Shen* as disclosing, teaching, or suggesting any elements of

Claims 1 and 10. As a result, Claims 2-9 and 11-18 are patentable due to their dependence from allowance base claims.

For these reasons, the Office Action does not establish a *prima facie* case of obviousness against Claims 2-9 and 11-18. Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 2-9 and 11-18.

III. NEW CLAIMS

The Applicants have added new Claims 22 and 23. The Applicants respectfully submit that no new matter has been added. At a minimum, the Applicants respectfully submit that Claims 22 and 23 are patentable for the reasons discussed above. The Applicants respectfully request entry and full allowance of Claims 22 and 23.

IV. CONCLUSION

The Applicants respectfully assert that all pending claims in this application are in condition for allowance and respectfully request full allowance of the claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Applicants have included the appropriate fee to cover the cost of two additional dependent claims. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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